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Paper No. 8
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Regent Lighting Corporation

Serial No. 75/508,824

Keith A. Vogt of Niro Scavone Haller & Niro for Regent
Lighting Corporation.

Gwen Stokols, Trademark Examining Attorney, Law Office 107
(Thomas Lamone, Managing Attorney).

Before Hanak, Chapman and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Regent Lighting Corporation seeks to register
SURVEILLANCE for "outdoor electric lighting fixtures and
electric light bulbs for outdoor lighting," in
International Class 11.¹

Registration has been finally refused on the ground
that the mark SURVEILLANCE is merely descriptive within the
meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C.

¹ Application Serial Number 75/508,824 was filed on June 25,
1998. The application is based upon applicant's claim of a *bona fide*
intention to use the mark in commerce.

§1052(e)(1). Applicant and the Trademark Examining Attorney have filed briefs, but an oral hearing was not requested.

It is well settled that a term is considered to be merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately conveys information about an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services with which it is being, or will be, used. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. On the other hand, the immediate idea must be conveyed with some "degree of particularity." In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. Feb. 13, 1991); In re TMS Corporation of the Americas, 200 USPQ 57, 59 (TTAB 1987).

Furthermore, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought. Thus,

"[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985). We must look to the context in which the term is being, or will be, used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. In re Bright-Crest Ltd., 204 USPQ 591, 593 (TTAB 1979).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multistage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See In re Abcor Development Corp., *supra* at 218, and In re Mayer-Beaton Corp., 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See In re Atavio, 25 USPQ2d 1361 (TTAB 1992) and In re TMS Corporation of the Americas, *supra* at 58. The distinction, furthermore, is often made on an intuitive basis rather

than as a result of precisely logical analysis susceptible of articulation. See In re George Weston Ltd., 228 USPQ 57, 58 (TTAB 1985).

The identification of goods is for "outdoor electric lighting fixtures and electric light bulbs for outdoor lighting." However, in order to discuss the nuances on which this case turns, we note that the total record shows these exterior lighting fixtures to be upscale, residential, security lighting. The lighting fixtures to which applicant has applied the SURVEILLANCE mark are ones prompted to turn on at night by motion sensors.² Although applicant's broad identification of goods does not specify any particular features of its lighting fixtures, certainly this identification would include security lighting prompted by motion detectors.

Applicant argues that the emphasis in the design of its goods is on the décor and styling; that the lighting involves relatively low wattage illumination rather than piercing flood lights; that others in the lighting field have not used the term "surveillance" in connection with

² This application is still an Intent-to-Use application, but as part of its response to the first Office action, applicant submitted photocopies of four pages of one of its brochures dealing specifically with its "SURVEILLANCE"™ motion activated floodlighting - Upscale Security Lighting Series."

such goods; and that a light is not capable, by itself, of "watching" or "observing," but rather can only provide "illumination." Finally, applicant argues that if there is doubt, the Board should reverse the Trademark Examining Attorney and have the mark published for opposition.

By contrast, the Trademark Examining Attorney relies upon a dictionary definition of the word "surveillance," as well as the five excerpted stories retrieved from a ten-year period of LEXIS/NEXIS stories referring to "surveillance lighting," reproduced below in the format provided to the Board:

"Where the place [Ronald Ronald's Rancho del Cielo in Santa Barbara] was once ringed by cameras, motion sensors and surveillance lights and guarded by a small army of Secret Service agents, the security now consists of a blind poodle ..." The Washington Post, April 24, 1998.

"A contractor was working on surveillance lights when the arm of his lift bucket stopped working about 6:15 p.m., fire department officials said." Union Leader, Manchester, NH, May 21, 1997.

"An interior alarm system and exterior surveillance lights were added in 1987 after the first of three vandalism incidents at the tomb in the last 10 years." Chicago Sun Times, February 25, 1997.

"Karen's father, a policeman, knew that the law was powerless against what seemed like a persistent creep. Even the surveillance lights Glenn's parents installed around their home had no effect last Feb. 16." Newsweek, July 13, 1992.

"... 1984-1985 month strike Massey -- which Smith was advising - hired armed security guards and installed

fences, observation posts and surveillance lights as a way to heighten tension, the report said." The Washington Post, October 23, 1989).

Applicant repeatedly argues that this scant LEXIS/NEXIS evidence is meaningless inasmuch as "the only group that uses the term 'surveillance' in connection with outdoor lights, other than Applicant, are columnists [sic] - a group well removed from the relevant lighting industry."

Granted, these few examples, *supra*, drawn from a gigantic database spanning more than ten years seem to reflect extremely rare usage of such terminology. Moreover, it is difficult to draw too many conclusions from these most abbreviated excerpts. Nonetheless, "surveillance lights" in the context of these uses often refers to security lighting for a public or commercial establishment where the lighting is integrated with more active security features. In the darkness, surveillance methodologies such as automated cameras and human guards are aided by lighting. If such lighting is specifically designed to help illuminate a security area for observation by a camera or a guard, it may well be seen as "surveillance lighting." Hence, while "surveillance lighting" may aid cameras or guards in their "watching" or

"observing," it is clear that a simple floodlight alone lacks the capacity to watch or observe.

On the other hand, we are not convinced by applicant's argument early on in the prosecution of this application that the involved goods are not correctly characterized as "security lights." Its brochures prove otherwise.

However, even so, both applicant and the Trademark Examining Attorney seem to agree that still leaves us with the question of whether security lights with motion sensors are truly involved in surveillance?

"Security" in the instant context is defined as 'something designed to assure safety.' Without a doubt, applicant is selling security lighting. Security or safety measures may be active, passive or some combination of the two. However, the definitions for "surveillance" include the concept of actively watching or observing. Thus, we find a different connotation from their respective dictionary definitions and from nuances in ordinary English-language usage.

In the context of safety measures for buildings, whenever there is active watching or observing going on, the words "security" and "surveillance" are used almost interchangeably with words like camera (i.e., "security camera" and "surveillance camera"), system (i.e., "security

system" and "surveillance system"), equipment (i.e., "security equipment" and "surveillance equipment"), etc. However, this is not the case with lights. That is, the word "security" is frequently used with light, lights, or lighting (including repeatedly by applicant in its brochures), while the record demonstrates that the word "surveillance" is almost never used with light, lights, or lighting. In those few examples where journalists have used this combined phrase, it seems to be in connection with lighting that aids the observations of a guard or the watchful eye of a camera. The question on which this case turns then, is whether a security light, that on its own illuminates an area outside a residence based upon a motion detector or motion sensor but itself does no active watching or observing fits the definition of "surveillance." We find it does not.

On the other hand, if these goods were defined as components of a larger security / surveillance system, or if applicant's lighting fixtures were fitted with a small camera (as some such devices are), we would be hard pressed not to affirm the position of the Trademark Examining Attorney.

This is a close case, but to the extent that we have doubt as to whether applicant's mark is merely descriptive

of its goods, we consider it appropriate to resolve such doubt in the favor of applicant. Then upon publication of applicant's mark, any person (including a juristic person) who believes that she/he/it would be damaged by the registration of the mark will have the opportunity to file an opposition thereto. See In re Merrill Lynch, Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); In re Rank Organization Ltd., 222 USPQ 324, 326 (TTAB 1984); In re Morton-Norwich Products, Inc., 209 USPQ 791 (TTAB 1981); and In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972).

Decision: The refusal to register is reversed.